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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/759,171      | 01/16/2001  | Lothar Zimmermann    | P20465              | 9812             |

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GREENBLUM & BERNSTEIN, P.L.C.  
1941 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT PAPER NUMBER

3726

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PC

**Office Action Summary**

Application No.

09/759,171

Applicant(s)

ZIMMERMANN, LOTHAR

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 24-46 and 48-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of **Group I, Claims 1-23 and 47** in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there is no apparent distinction between inserting a core into a covering layer and applying a covering layer onto a core. This is not found persuasive because there is no disclosure supporting inserting a the core into the cover in applicant's invention. Also, it is noted that the product can be made without an elastic covering layer. There is a serious burden in searching both the product and process claims because the search for a product does not necessarily entail the search for the process.

The requirement is still deemed proper and is therefore made FINAL.

### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Information Disclosure Statement*

3. The information disclosure statement filed 3/14/2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The

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foreign patents listed in the information disclosure statement do not have an English abstract or an explanation of their relevance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1-23 and 47** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims require that the at least one thermoplastic has a melting temperature which is below a glass transition temperature of the at least one thermosetting plastic. There is a lack of disclosure on what type of thermoplastic or thermosetting plastics could be combinable with each other. There are no examples of which thermosetting plastics or thermoplastics could be combinable. Therefore, one skilled in the art would not be able to practice the invention without undue experimentation since it is unclear which types of thermosetting plastics or thermoplastics could be combined with each other. Are all thermoplastics combinable with all thermosetting plastics?

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-8, 12, 13, 16-18, 20, and 21** are rejected under 35 U.S.C. 102(b) as being anticipated by Holroyd et al. (2,534,818).

Holroyd et al. teach a roll for smoothing a web comprising: a hard metal (col. 3, line 37) roll core **10** having an outer surface, a covering layer **12** disposed on the outer surface of the roll core **10**, the covering layer **12** having an inner surface and an outer surface, the covering layer **12** comprising at least one thermosetting plastic (col. 2, line 17 and col. 4, lines 64-68) and at least one thermoplastic (col. 2, line 20 and col. 4, lines 68-70). Note that the covering layer **12** comprises a matrix material and wherein one of fillers and fibers (col. 3 lines 67-75 to col. 4, lines 1-5) are embedded in the matrix material. The amount of thermosetting plastic is greater than the amount of thermoplastic (col. 3, lines 14-18). The claimed proportions of thermosetting plastic to thermoplastic is shown at col. 3, lines 14-18.

The web being a paper web does not further limit the structure of the roll and has not been given patentable weight.

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8. **Claims 23 and 47** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holroyd et al. in view of Yamada et al. (5,514,466).

Holroyd et al. teach using thermosetting plastic (col. 4, lines 64-68) and thermoplastic (col. 4, lines 68-71). It appears inherent that the thermoplastic used has a melting temperature which is below a glass transition temperature of the at least one thermosetting plastic since Holroyd et al. teach using different types of thermoplastic and thermosetting plastics.

Yamada et al. teach using a thermosetting resins having high glass transition temperatures (col. 1, lines 60-66).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Holroyd et al. with a thermosetting resin having a high glass transition temperature, in light of the teachings of Yamada et al., in order to provide better heat resistance (col. 1, lines 65-66 of Yamada et al.).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 9-11, 14, 15, 19, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Holroyd et al.

With respect to Claims 9-11, Holroyd et al. teach the invention cited above with the exception of using at least two different thermoplastics and at least two different thermosetting plastics.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use at least two different thermoplastics and at least two different thermosetting plastics because applicant has not disclosed that using at least two different thermoplastics and at least two different thermosetting plastics provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either one thermoplastic and one thermosetting plastic as taught by Holroyd et al. or the claimed at least two different thermoplastics and at least two different thermosetting plastics because both combinations perform the same function of providing a layer that work equally as well considering the desired heat resistance on the surface of the roll.

With respect to Claims 14 and 15, Holroyd et al. teach the invention cited above with the exception of the mixture ratio varying over a radial thickness of the covering layer.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided a mixture ratio that varies over a radial thickness of the covering layer because applicant has not disclosed that a mixture ratio that varies over a radial thickness of the covering layer provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either mixture ratio as taught by Holroyd et al. or the claimed mixture ratio that varies over a radial thickness of the covering

layer because both mixture ratios perform the same function of providing a layer that work equally as well considering the desired heat resistance on the surface of the roll.

With respect to Claims 19 official notice is taken that it is well known in the art to use the claimed reinforcing fibers.

With respect to Claim 22, Holroyd et al. teach the invention cited above with the exception of using powdered fillers.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used powdered fillers because applicant has not disclosed powdered fillers provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the fibers taught by Holroyd et al. or the claimed powdered fillers because both fillers perform the same function of providing a reinforcement equally as well considering the desired reinforcement of the surface layer.

### ***Contact Information***

11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies



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of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Thursday and the second Friday of the bi-week, between 9am-6pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

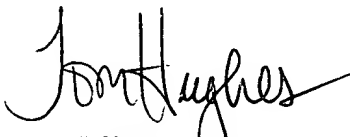
Other helpful telephone numbers are listed for applicant's benefit.

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MJ  
June 2, 2002

  
S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700